

REMARKS

I. Status of claims

Claims 37, 40-43, and 54 are pending in this application. By this Amendment, claim 37 has been amended and claims 44, 45, and 47-50 have been canceled. The Amendment should be entered after final rejection because it simplifies issues for appeal by canceling multiple claims and consolidating independent claims. No new matter has been added by these amendments.

II. Claim Rejections under 35.U.S.C. §103(a)

A. Claims 37 and 40-43

Claims 37 and 40-43 have been rejected under 35 U.S.C. § 103(a) over U.S. Patent No. 6,070,153 to Simpson in view of U.S. Patent No. 6,631,358 B1 to Ogilvie, in view of U.S. Patent No. 6,345,261 B1 to Feidelson et al. (hereinafter “Feidelson”) and in further view of U.S. Patent No. 5,940,811 to Norris. This rejection is respectfully traversed.

Even if combined, Simpson, Ogilvie, Feidelson, and Norris fail to disclose the features of independent claim 37. In summary, the Office Action fails to establish a *prima facie* case of obviousness. Specifically, before considering what would be obvious to one of ordinary skill in the art at the time of the invention, the art must teach or suggest the claim limitations. See MPEP §2143.

Simpson discloses a system in which a card issuer offers an investment account to customers having credit accounts. Simpson provides applicants with two applications, one for a credit account and one for an investment account (See Fig. 1, steps 1, 2A, and 3). Multiple

funding arrangements for the investment account are offered in Simpson and these funding arrangements may be combined.

Even if combined, the references fail to disclose all of the features of independent claims 37 and 44. With respect to claim 37, which requires a computerized method for implementation of multiple accounts, the references fail to show multiple features. None of the references discloses a first set of features (I) including providing an investment fund card application to an applicant, the investment fund card application for establishment of both a card payment instrument account and an investment account, approving the submitted investment fund card application, and establishing the card payment instrument account through the card issuer for the approved cardholder upon approval, wherein the card payment instrument account includes a reward feature available to the cardholder. The references further fail to show automatically creating the investment account for the approved cardholder through the financial institution upon approval of the investment fund card application, creation of the investment account triggered upon issuance of the card payment instrument.

Specifically, Simpson fails to disclose an investment fund card application. Simpson discloses two separate applications, one for an investment fund and another for a credit card. The Office Action alleges that Ogilvie discloses this feature. Ogilvie discloses an arrangement between a consumer and a credit card issuer that allows funds to be deposited on behalf of the consumer in a consumer-specified account. The portion of Ogilvie referenced by the Examiner (Column 1, lines 56-57) to show that only one application is used refers to a prior art arrangement in which a bank issuing a credit card also holds an account in which consumer funds can be deposited. Thus, since only one entity (the card issuer) is involved with the consumer in the system of Ogilvie, the one application is only for services with the card issuing

entity and not with two entities as required by claim 37. Thus, the disclosure of Ogilvie does not include providing an investment fund card application to an applicant, the investment fund card application entitling an approved cardholder to establish a card payment instrument account *with a card issuer* and an investment account *with a financial institution* as required by claim 37. The financial institution and the card issuer are claimed as differing entities such that a reward structure is established *through an agreement between the financial institution and the card issuer*. Thus, in order to provide a sufficient teaching, a reference would at least have to teach a single application for services through two different entities rather than through the same entities.

Although the Office Action references additional sections (Figs. 2 and 3) of Ogilvie to show that Ogilvie discloses two entities, these sections are entirely unrelated to the prior art disclosure referenced in column 1 of the Principal Bank Visa Card, which implemented a single application sent to a single entity that is responsible for maintaining both the card account and the investment account. In fact, the additional portion referenced by the Examiner merely provides support for the contention that Ogilvie and Simpson both teach away from the use of a single application for establishing multiple accounts with multiple entities as required by the pending independent claims. Furthermore, the contention that using a single application to apply for two financial accounts maintained by different entities is “old and well known”, which appears in the first full paragraph of page 14 of the Office Action is respectfully traversed. The Examiner has been unable to produce any reference showing this feature and the fact that all of the references applied by the Examiner show a markedly different structure supports the contention that this method is not in fact known in the art at all.

As noted in the Office Action, Simpson also fails to disclose a second set of features (II) including issuing a card payment instrument linked to the multiple accounts, the card payment instrument bearing the name of the financial institution and the name of the card issuer.

Ogilvie, Feidelson, and Norris fail to obviate the deficiencies of Simpson. Specifically, none of these references discloses feature set (II) above including a credit card bearing two names including the name of a financial institution and that of a credit card issuer as required by claim 37. The Office Action references Feidelson for this feature. However, Feidelson merely discloses that a card may be a co-branded credit card between an administrator and a credit card issuer. This disclosure in itself does not necessarily pertain to the physical features of the card such that the card bears the name of a financial institution and a credit card issuer as required by pending claim 37.

Further, the references fail to disclose a third set of features (III) including automatically creating the investment account based on notification from the card issuer to the financial institution upon application approval for the investment card for the applicant.

Additionally, the combination of references fails to disclose simultaneously offering multiple accounts including the card payment instrument account through the card issuer and the investment account from the financial institution by providing an investment card application.

The references collectively further fail to disclose that when a recipient of an offer for multiple accounts accepts the offer for multiple accounts by completing the investment card application, the card payment instrument account is established in response to approval of the application. Specifically, in Simpson, multiple applications must be completed for multiple accounts. In Simpson, the investment account can only be opened when the cardholder completes a separate application.

Furthermore, claim 37 includes selecting, using a reward issue and transfer system operated by the card issuer, a transfer destination for the reward, wherein the transfer destination is selected from the established investment account and an alternative destination; and transferring the monetary reward amount generated by the reward feature to the selected destination at predetermined time intervals. The references fail to disclose this claimed feature.

It is beyond dispute that KSR grants the Examiner a more flexible framework for conducting the obviousness inquiry. However, the principle that a well-founded rejection must *account for the invention as a whole including all claim limitations* still applies, else the rejection cannot be sustained. KSR Intern. Co. v. Teleflex Inc., 127 S.Ct. 1727, 1734, 1740 (2007)(inquiry based on “the subject matter as a whole”, “claimed subject matter”); 35 U.S.C. § 103 (“subject matter as a whole”); MPEP §§ 2141.02 (“Claimed invention as a whole must be considered”), 2143.03 (“All claim limitations must be considered”); 2143.A (obviousness rejection must show “each element claimed”, “all the claimed elements”); *see In re Lowry*, 32 F.3d 1579, 32 USPQ.2d 1031, 1034 (Fed. Cir. 1994)(examiner must consider all claim limitations when determining patentability of invention over prior art)(citing In re Gulack, 703 F.2d 1381, 217 USPQ 401, 405 (Fed. Cir. 1983)); In re Wilson, 424 F.2d 1382, 165 USPQ 494, 496 (CCPA 1970)(“All words in a claim must be considered in judging the patentability of that claim against the prior art.”).

Additionally, the asserted modifications of Simpson would not have been obvious to one of ordinary skill in the art. In arriving at the solution of opening an investment account in response to an application for a credit card, Applicant analyzed the current state of individual investment to determine that consumers find investing to involve excessive burdens, particularly the burden required to proactively establish investment accounts. As stated in the summary of

the invention (paragraph 3 on page 4), applicant has provided an automatic method for establishing an investment account that relieves the consumer of the burden of having to proactively establish the account.

While the Examiner provides the motivation (on page 6 of the Office Action) that since both accounts are set up using an individual's personal data, establishing both accounts with one application would have been obvious because it would have minimized errors in the application process. However, Although the suggestion to combine references may flow from the nature of the problem, '[d]efining the problem in terms of its solution reveals improper hindsight in the selection of the prior art relevant to obviousness.'" Monarch Knitting Mach. Corp. v. Sulzer Morat GmbH, 139 F.3d 877, 881 (Fed. Cir. 1998).

A prior art reference must be considered in its entirety, i.e. as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir 1983), cert. denied, 469 U.S. 851 (1984).

Thus, because the references, even if combined, fail to disclose the features of the invention of claim 37 and further because no motivation, teaching, or suggestion has been provided for arriving at the combination of features, the Office Action has failed to establish a *prima facie* case of obviousness. Likewise, dependent claims 40-43 depend from claim 37 and therefore define over the art of record for the reasons set forth above with respect to claim 37.

Dependent claims 40-43, 45, and 54 define further distinctive features of the invention and define over the art of record for at least the reasons set forth above with respect to claim 37. Applicants respectfully traverse and request withdrawal of this rejection under 35 U.S.C. §103 as it may be applied to the currently pending claims.

B. Claims 44, 45, 47-50 and 54

Claims 44, 45, 47-50 and 54 have been rejected under 35 U.S.C. § 103(a) over Simpson in view of Ogilvie, and in further view of Feidelson et al. (hereinafter "Feidelson"). This rejection is now moot as independent claim 44 has been canceled. Withdrawal of the rejection is respectfully requested.

III. Response to Additional Comments

Applicant has fully considered and appreciates the thorough analysis provided in the Examiner's additional comments. The claims have been amended in view of some of these additional considerations.

Applicant notes that the business article, LoanWise.com can be distinguished from the claimed invention in that it merely provides an application for offers and not for actual products. It is likely that upon receiving offers, the potential recipient, which is a business recipient and not an individual recipient, would be required to fill out an additional application. This is certainly true of currently existing Internet systems which solicit applicants for financial services. It is unclear from the Loanwise reference, what follow up steps are required by those seeking business loans and thus, Applicant believes that this reference fails to substantively contribute to a *prima facie* case of obviousness with respect to the pending claims.

With respect to the disclosure of Fiedelson, the form referenced in the Office Action offers a credit application as a supplement to a registration for a merchant rewards program. Applicant believes that the program of Fiedelson substantially differs from the claimed invention as well as from the invention disclosed by Simpson and its value as a secondary reference is limited.

With respect to the Ogilvie reference, Applicant believes that the contents of the Ogilvie reference have been thoroughly address in other sections of the response.

IV. Conclusion

As set forth above, applicant respectfully submits that all claims are in condition for allowance. Withdrawal of all rejections and prompt passage to issuance are earnestly requested. In the event Applicant has overlooked the need for an extension of time, payment of fee, or additional payment of fee, Applicant hereby petitions therefore and authorizes that any charges be made to Deposit Account No. 50-4494.

Should the Examiner have any questions regarding any of the above, the Examiner is respectfully requested to telephone the undersigned at 202-346-4016.

Dated: March 2, 2010

Respectfully Submitted,

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